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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/669,249

09/25/2003

Takeshi Kanai

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03/26/2008

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EXAMINER

TERMANINI, SAMIR

ART UNIT

PAPER NUMBER

2178

NOTIFICATION DATE

DELIVERY MODE

03/26/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/669,249 | Applicant(s) KANAI, TAKESHI | |
| | Examiner Samir Termanini | Art Unit 2178 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-5 and 7-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/17/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

BACKGROUND

1. This Non-Final Office Action is responsive to the following communications: Amendment filed on 12/21/2007.

2. Claim(s) 1-4, and 7-9 are pending. Claim(s) 1, 4, and 7 are independent in form. Claims 7-9 are newly added.

INFORMATION DISCLOSURE STATEMENT

3.. The information disclosure statement (IDS) filed on 10/17/2007 has been acknowledged and considered by the examiner. The Initial copy of form PTO-1449 is included in this office action.

RESPONSE TO AMENDMENT

4. Arguments concerning the Examiner's prior Rejections of Claims 1-5 are under 35 U.S.C. 103(a) for being unpatentable over Harada et al. (U.S. Pat No. 6,486,890) in view of Iwata et al. (PG-Pub No. US 2002/0073122 A1) have been fully considered and are persuasive. Therefore, the rejection(s) have been withdrawn.

CLAIM REJECTIONS-35 U.S.C. §102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1, 4, 5, and 7** are rejected under 35 U.S.C. 102(e) as being anticipated by *Huttunen* (U.S. PG Pub 2003/0069881).

I. Citation of Prior Art

A reference to specific paragraphs, columns, pages, or figures in a cited prior art reference is not limited to preferred embodiments or any specific examples¹. It is well settled that a prior art reference, in its entirety, must be considered for all that it expressly teaches and fairly suggests to one having ordinary skill in the art². Stated differently, a prior art disclosure reading on a limitation of Applicant's claim cannot be ignored on the ground that other embodiments disclosed were instead cited. Therefore, the Examiner's citation to a specific portion of a single prior art reference is not intended to exclusively dictate, but rather, to demonstrate an exemplary instance where the disclosure is commensurate with the specific limitation(s) being addressed.

II. Prior Art Anticipation of Claimed Limitations.

¹ *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)).

² *Upsher-Smith Labs. v. Pamlab, LLC*, 412 F.3d 1319, 1323, 75 USPQ2d 1213, 1215 (Fed. Cir. 2005); *In re Fritch*, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1782 (Fed. Cir. 1992); *Merck & Co. v. Biocraft Labs., Inc.*, 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989); *In re Fracalossi*, 681 F.2d 792, 794 n.1, 215 USPQ 569, 570 n.1 (CCPA 1982); *In re Lamberti*, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976); *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

As to independent **claim 1**, *Huttunen* describes: An information processing device comprising: storage means for storing content data of predetermined content ("...those nodes are stored...", para. [0099]); and display control means for controlling display of the predetermined content based on the stored content data ("...A fragment, as the term is used herein, is a portion of document which results from partitioning or parsing of the document for transmission to a user's device for rendering and display thereon...", para. [0009]), wherein: the predetermined content is divided into a plurality of blocks to be consecutively displayed ("...The size of the fragment is compared to a predetermined threshold that is selected based on a characteristic of a receiving device configured to receive and render the fragment...", para. [0024]), and the content data includes positional data which relates to the blocks and which is for setting a position of a subsequent block relative to the position of a previous block ("...The partitioning agent also needs to know the maximum size of the fragment in each situation, and whether the user wants a next or previous fragment, i.e. the partitioning direction...", para. [0060]); and said display control means controls the display of the predetermined content by ("...the size of a memory area for illuminating the display pixels on the device 112, and the type of the type of device 112, and may be determined by the DPA 224 or the device 112...", para. [0082]), based on the positional data ("...illuminating the display pixels on the device 112...", para. [0082]), sequentially controlling display of one predetermined block in a predetermined position in units of the blocks ("...The user may also select via the input means user preferences, such as instructions that any relevant image may be split between subsequently displayed screens. The user operates the

input means to issue the request for a next or preceding fragment in the document order for transmission back to the user device....," para. [0118]), said positional data including data that describes the position of the subsequent block in terms relative to the position of the previous block ("...If a matching node is found, a link 352 to the previous fragment is added to the current fragment 222; otherwise, the root element has been reached, and a link 352 to the previous fragment will not be added to the current fragment 222 since there is no prior fragment....," para. [0115]).

As to independent **claim 4**, this claim differs from claim 1 only in that it is directed to a method carried out by apparatus of claim 1. Accordingly, this claim is rejected for the same reasons set forth in the treatment of claim 1, above.

As to independent **claim 5**, this claim differs from claim 4 only in that the latter is directed to a product defined by the process of the former. Accordingly, this claim is rejected for the same reasons set forth in the treatment of claim 4, above.

As to independent **claim 7**, this claim differs insubstantially from claim 1 and is rejected for the same reasons set forth in the treatment of claim 1, above.

CLAIM REJECTIONS-35 U.S.C. § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 2-3 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Huttunen* (U.S. PG Pub 2003/0069881) in view of *Harada et al.* (U.S. Pat No. 6,486,890).

I. Scope of the Prior Art and the Level of Ordinary Skill³

Harada et al. disclose an image display device having a main body with a display screen A and a second display screen B and a physical hinge connecting them. The two play units are opened and closed at the link so that display screens are folded over each other for carrying like a book, and they are opened in a use mode to permit the recognition of the display image.

Huttunen teaches a structured document being partitioned to produce a fragment for output to a mobile device for rendering and display. The fragment includes forward and backward links to allow the user of the device to navigate the document by requesting fragments of previous or subsequent context in the document hierarchy. User preferences, architectural limitation parameters, and the partitioning direction

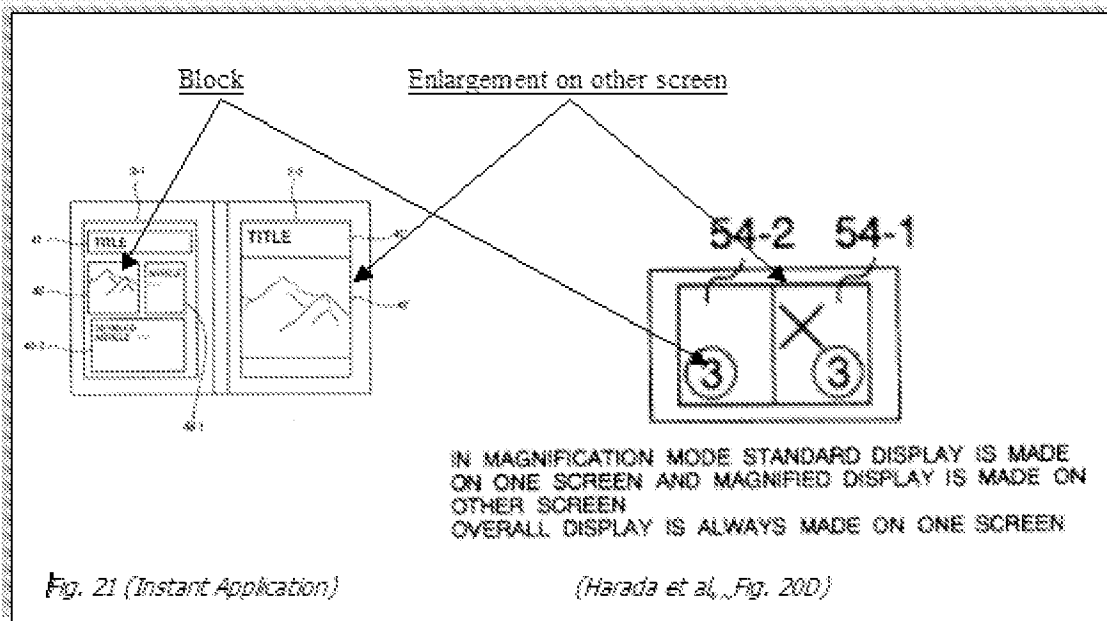
³ "Factors that may be considered in determining level of ordinary skill in the art include (1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of active workers in the field." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 696, 218 USPQ 865, 868 (Fed. Cir. 1983), cert. denied, 464 U.S. 1043 (1984).

are included in a request from the device, and with predetermined partitioning rules, are used to partition the annotated document to yield the displayable fragment.

II. Obviousness and Analysis of Claimed Differences

As to dependent **claim 2**, *Huttunen* taught the limitations of claim 1 addressed above. However, *Huttunen* differs from claim 2 because it does not clearly teach that the display control means controls two different screens.

On the other hand, *Harada et al.* teach a display control means controlling two different screens ("two LCD screens 54-1 and 54-2," col. 22, lines 11-23), and in said display control means, display of the content based on the content data on one screen is controlled and display on the other screen of content formed by enlarging the predetermined block in the predetermined content ("Entire Image on One Side and Magnified Image on the Other Side. When two pages are displayed on the two LCD screens (54-1 and 54-2) and one of the LCDs (for example, the right 54-1) is magnified," col. 22, lines 11-23). Further shown below:



As shown and compared above, *Harada et al.* teach in Fig. 20D, *inter alia*, the predetermined block for which enlargement is directed.

It would have been obvious to one ordinary skill in the relevant field at the time the invention was made to use two screens to having the positional data taught of *Huttunen*, as claimed, because *Harada et al.* teaches the use of positional data for the portioned display on image display devices ("...information of a predetermined format...", col. 6, lines 28-29; see also predetermined amount of data, col. 13, lines 50-60; see also, "appear sequentially," col. 8, lines. 1-15; see also, "the first page is disappeared from the display and the next page is moved to the screen on which the disappeared page was displayed and the next new page is displayed." col. 23, lines 38-44).

As to dependent **claim 3**, *Huttunen* taught the limitations of claim 1 addressed above. However, *Huttunen* differs from claim 3 because it does not clearly teach that an enlargement is directed for the predetermined block at a predetermined magnification.

However, *Harada et al.* further teach that the enlargement is directed for the predetermined block (Fig 20D, above) said display control means extracts pieces of the content data (“...the data on the record medium is read and...decompressed...by the decompressor 513 and it is transferred to the memory circuit 515,” col. 18, lines 14-18) which relate to the predetermined block for which the enlargement is directed (display control means is able to direct enlargement, e.g. a VRAM 516 that is divided into two parts corresponding to the two display screens 54-1 and 54-2 of the LCD 54.), and controls content based on the pieces of the content data so as to be displayed at a predetermined magnification (e.g. magnified by a factor of two, col. 13, lines 64-65).

It would have been obvious to one ordinary skill in the relevant field at the time the invention was made to use an enlargement is directed for the predetermined block at a predetermined magnification as taught in *Harada et al.* with the device in *Huttunen* because, in the same field of endeavor of displaying blocks on small devices, *Huttunen* teaches the partitioning that *Harada et al.* disclose in solving the problem of displaying larger blocks on small screens:

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The ultimate goal of document partitioning is to improve the accessibility and usability of documents. Partitioning makes it possible either to access documents via new devices or to render them in a new way allowing, for example, mobile Internet connectivity or more usable and efficient document use for user devices that were previously able to access the same information in a different way. Partitions of documents are, by definition, smaller in size than the original document (although real-world solutions need to embed some metadata with the fragments). Small size allows shorter access times, which is especially important with large documents and with the relatively low network connection bandwidths currently used in wireless networks. Although not required for partitioning, user preferences are natural add-ons to partitioning rules. Preferences allow document partitions to be more customizable and thus more usable.

(para. [0041]).

As to dependent **claims 8 and 9**, these claims differs insubstantially from claims 2 and 3. Therefore, claims 8 and 9 are rejected for the same reasons set forth in the treatment of claims 2 and 3, above.

RESPONSE TO ARGUMENTS

9. Applicant arguments, see pp. 6-9 filed 12/21/2007, with respect to the Rejections cited by the Examiner in the previous Office Action (Mail dated: 10/09/2007), of Claims 1-5 are under 35 U.S.C. 103(a) for being unpatentable over Harada et al. (U.S. Pat No. 6,486,890) in view of Iwata et al. (PG-Pub No. US 2002/0073122 A1) have been fully considered and are persuasive. Therefore, the rejection(s) have been withdrawn. However, upon further search, a new ground(s) of rejection is made in view of newly discovered prior art (i.e., *Huttunen*), addressed above.

10. Applicant's remaining arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection because they are directed toward rejections that have been withdrawn, see above.

CONCLUSION

11. All prior art made of record in this Office Action or as cited on form PTO-892 notwithstanding being relied upon, is considered pertinent to applicant's disclosure. Therefore, Applicant is required under 37 CFR §1.111(c) to consider these references fully when responding to this Office Action.

- [1] Kuno et al. (US Pat. No. 5,467,102) for teaching a portable display device capable of presenting simultaneous display of different parts of the document in reasonable sizes on at least two display screens.
- [2] Reavey et al. (US Pat. No. 5,847,698) for teaching an electronic book device with means for orientating the material on the electronic display unit responsive to an opening position of the electronic book device.
- [3] Rohrabough et al. (PG-PUB 20020091738 A1) for teaching resolution-independent vector display of internet content to allow it to be scaled (zoomed) larger and smaller for better viewing or to fit any resolution or screen size.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Samir Termanini at telephone number is (571) 270-1047. The Examiner can normally be reached from 9 A.M. to 6 P.M., Monday through Friday.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Stephen S. Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Samir Termanini/

Examiner, Art Unit 2178

/Stephen S. Hong/

Supervisory Patent Examiner, Art Unit 2178